

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICANT(S) | Steele, et al.  | GROUP ART UNIT:  | 3622            |
| APPLN. NO.:  | 09/414,121  | EXAMINER:        | Alvarez, Raquel |
| FILED:       | October 8, 1999   | Confirmation No. | 2811            |
| TITLE:       | REMOTELY CONFIGURABLE MULTIMEDIA ENTERTAINMENT<br>AND INFORMATION SYSTEM WITH LOCATION BASED<br>ADVERTISING |                  |                 |

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RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Sir:

In response to the Office Action dated October 10, 2006, Applicants submit herewith an Amended Brief under 37 CFR 41.37.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

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Ex Parte: STEELE, SCOTT  
Application Number: 09/414,121  
Filing Date: October 8, 1999  
Title: Remotely Configurable Multimedia  
Entertainment and Information System  
With Location Based Advertising  
  
Group: 3622  
Examiner: RAQUEL ALVAREZ

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AMENDED BRIEF ON BEHALF OF APPELLANTS UNDER 37 CFR 41.37

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I. REAL PARTY IN INTEREST

The name of the real party in interest for purposes of this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Applicant, the Applicant's legal representative, or assignee which would directly affect or be directly affected by or having a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 3, 4, 9, 10, 12, 14, 18, 20, 21 and 23-27 have been canceled. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 remain in the application. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 are being appealed. Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 stand or fall together.

In a Final Office Action dated January 14, 2005, the Examiner rejected Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (USPN 6,183,366) in view of Hall (USPN 6,026,375), and rejected Claims 7, 8, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (USPN 6,183,366) in view of Hall (USPN 6,026,375) and further in view of Titmuss et al. (WO 98/47295).

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the Final Office Action mailed January 14, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Although specification citations are inserted below in accordance with 37 C.F.R. § 41.37, these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the brief. There is no intention to in any way suggest that the terms of the claims are limited to the examples in the specification.

Although, as demonstrated by the reference numerals and citations below, the claims are fully supported by the specification as required by law, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with rule 41.37, does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the reference numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

The invention, as defined in independent Claim 1, and with reference to FIGS. 6A and 6B, is a method of providing service in a wireless communication network comprising the steps of: providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription to one of said service options; providing a quota of advertisements (504, 512) to the end user within a predetermined time period in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device and when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time;

determining whether the advertisements have been delivered; and terminating advertisements upon reaching the quota. (Specification pages 19-22 and page 28 lines 17-18).

The invention, as defined in independent Claim 13, and with reference to FIGS. 6A and 6B is a method of providing service in a wireless communication network comprising the steps of: providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription to one of said service options; providing a quota of advertisements (504, 512) to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device and when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time; requiring user interaction (514, 516) to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service; and terminating advertisements upon reaching the quota. (Specification pages 19-22 and page 28 lines 17-18).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 are patentable under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall?
- B. Whether Claims 7, 8, 15 and 16 are patentable under 35 U.S.C. §103(a) over Goldberg et al. in view of Hall and further in view of Titmuss et al.?

## VII. ARGUMENT

A. Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (US 6,183,366) in view of Hall (US 6,026,375).

Specifically, with respect to the independent claims 1 and 13, the Examiner contended that the termination of advertisements using a quota is obvious. However, the Examiner has shown no evidence of any case where advertisements are terminated while the information or entertainment service access continues advertisement free. The Examiner previously admitted that neither Goldberg nor Hall disclose the provision for a quota within a predetermined time period and terminating advertisements upon reaching the quota. In addition, the Examiner previously admitted that Goldberg does not recite the ending of advertisements, and appellants submit that it is a common practice in the industry for advertisements to be continually presented. However, the Examiner further presumes that it would make sense in Goldberg to terminate advertisements when users have satisfied their thresholds to prevent overexposure. Goldberg does not suggest or disclose the termination of advertisement, does not suggest or disclose thresholds, and does not suggest or disclose the prevention of overexposure. This is all speculation on the part of the Examiner with no prior art cited thereon. Further, appellants disagree that it is well known for termination to occur as the actual practice teaches away from this (i.e. advertisement never terminate, there are no thresholds in advertising, and there are no concerns about overexposure to advertising).

Moreover, independent claims 1 and 13 recite a specific technique to provide the previously unknown service of the present invention, using quotas to terminate advertising. The Examiner previously admitted that neither Goldberg nor Hall disclose the provision for a quota within a predetermined time period and terminating advertisements upon reaching the quota.

Since no prior art has been shown to terminate advertisements while continuing service, appellants submit that it is completely non-obvious to use a quota system to terminate advertisements while continuing service.

In addition, appellants wish to reiterate that Goldberg recites that Internet access is free while advertisements are repeatedly downloaded (col. 29, lines 15-20), without condition. Therefore, the implication is that if advertisements could not be repeatedly downloaded then internet access would not be free. As a result, the effect is that free internet access is subject to continually receiving advertisements. In addition, if Goldberg had envisioned the cessation of advertisements upon reaching a quota then Goldberg would not refer to the *repeated* downloading of advertisement. Since Goldberg did not qualify this statement, it must be taken as one normally skilled in the art would interpret it, i.e. advertisements never end, there is no threshold, there is no quota, and there is no concern about overexposure, as is the commonly recognized normal business practice, which teaches away from appellants' invention.

Therefore, appellants believe the Examiner has made an error in interpreting Goldberg as reciting: a) the ending of advertisements, b) quotas, and c) thresholds for quotas. Appellants wish to repeat that there are presently no known provisions in such cases for the termination of advertisements while continuing service access, and further that that there is no mention of quotas for the termination of advertisements while continuing service access. Appellants respectfully reiterate that these two steps are essential in the understanding of appellants' invention, and neither are present in the cited art. Further, since the use of advertisement quotas is unknown in the art it would not be obvious to use advertisement quotas for the termination of advertisements while continuing service access. Even one skilled in the art could not make these



two leaps, and in fact has not made these leaps. Although the Examiner has indicated that it would make *sense* that it were so, there has been no art cited in this regard. Moreover, if common sense were the only criteria, then common sense would dictate exactly the opposite of the Examiner's assertion, namely advertisements never stop.

Moreover, appellants point out that to establish *prima facie* obviousness of a claimed invention, at least the two limitations of must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the appellants' specification, it is a substantial benefit to use the claimed invention because it uses a quota to permit a user relief from relentless presentation of advertisements. The known art, for the reasons mentioned above, simply does not suggest the desirability of the claimed invention since it doesn't provide for the termination of advertisements while continuing Internet access.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art),

and in particular where the known art teaches away from appellants' invention as explained above.

Advantageously, appellants' invention of amended independent claims 1 and 13 provides a business case that is unknown in the art wherein an Internet service provider would provide an advantage for a user to use that particular access provider by the knowledge that advertisements will stop after reaching a quota whereinafter the user would have uninterrupted Internet access. In this way, the use of quotas would be much more likely to lure users to a service, in that, a user would be much likely to subscribe to a service if they knew they would not be subject to an endless barrage of advertising, but instead be subject to a fair portion of advertising in exchange for their patronage.

Therefore, appellants respectfully submit that the previously amended independent claims 1 and 13 are novel and non-obvious over Goldberg and Hall, and are therefore deemed allowable.

Regarding dependent claims 2, 5, 6 and 11, because claims 2, 5, 6 and 11 depend directly or indirectly from independent claim 1, the appellants respectfully submit that claims 2, 5, 6 and 11 are not unpatentable over the prior art of record.

Regarding independent claim 13, the above comments with respect to claim 1 also apply to claim 13. In addition, the cited art teaches a system to check whether advertisements are presented in a destination device, but does not provide a definitive technique to guarantee that a user actually observes the advertisement from the destination device. For example, a user may be outside their car while an advertisement is playing, and therefore does not observe the

advertisement. Appellants solve this problem by requiring a manual interaction where the user actually acknowledges the receipt of the advertisement. The inclusion of manual feedback is a significant difference from the cited art, and the Examiner admits that Goldberg does not teach manual acknowledgment. Therefore, appellants' invention of claim 13 solves a problem that is not addressed by the cited art.

Again, the Examiner goes on to state that a provision to have a user manually acknowledge an advertisement is obvious since it is old and well known in the prior art. However, to establish *prima facie* obviousness of a claimed invention, the practice of a user manually acknowledging advertisements must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, there is no art cited that has a user manually acknowledge the receipt of advertisements. Indeed, appellants respectfully submit that it is not old and well known for a user to provide a manual acknowledgement that they have viewed an advertisement. In contrast, appellants submit that it is quite uncommon to provide any acknowledgement that an advertisement has been viewed and that in fact it is the common business practice to not require any acknowledgement. Therefore, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the appellants' specification, there

is a benefit to a service provider to supply definitive evidence that an advertisement has been actually viewed by have a viewer manually acknowledge same. The known art, for the reasons mentioned above, simply does not suggest the desirability of providing manual interaction, but instead providing a convoluted automatic process between devices that only proves the advertisement was presented by a device, but does not guarantee that the advertisement was reviewed by an actual person. The prior art only describes a user that interacts with an advertisement of interest to gain more information. This is not done for the purposes of acknowledgement that the user has received the advertisement, but is only incidental thereto, and therefore teaches away from appellants' invention.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art), and in particular where the known art teaches away from appellants' invention as explained above.

Regarding dependent claims 17, 19 and 22, because claims 17, 19 and 22 depend directly or indirectly from independent claim 13, the appellants respectfully submit that claims 17, 19 and 22 are not unpatentable over the prior art of record.

Therefore, since limitations are missing from the Goldberg, et al. and Hall references, a rejection of Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

B. Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (US 6,183,366) in view of Hall (US 6,026,375) and further in view of Titmuss et al. (WO 98/47295).

Regarding dependent claims 7 and 8, because claims 7 and 8 depend directly or indirectly from independent claim 1, the appellants respectfully submit that claims 7 and 8 are not unpatentable over the prior art of record.

Regarding dependent claims 15 and 16, because claims 15 and 16 depend directly or indirectly from independent claim 13, the appellants respectfully submit that claims 15 and 16 are not unpatentable over the prior art of record.

Appellants respectfully submit that the prior art references, in combination or alone, fail to teach or suggest all of appellants' claimed limitations, as required for a 35 USC §103(a) rejection. Namely, with regard to claims 1 and 13 (and their dependent claims), none of the references teach at least the steps of: providing a quota of advertising, determining whether advertisements actually have been viewed, terminating advertisements upon reaching a quota, or providing advertisements based upon the status of sensors in a vehicle. Further, with regard to claim 13, none of the references teaches at least the step of requiring user interaction to determine whether an advertisement was reviewed. Appellants submit that these many limitations can not all be rendered obvious without any corroborating references.

Therefore, since limitations are missing from the Goldberg, et al., Hall and Titmuss, et al. references, a rejection of Claims 1, 2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

For the reason set forth above, Applicants submit that the Examiner has incorrectly rejected Claims 1-2, 5-8, 11, 13, 15-17, 19 and 22 under 35 U.S.C. § 103(a) and request that the Board withdraw the rejections.

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

1. (previously presented) A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options;

providing a quota of advertisements to the end user within a predetermined time period in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device and when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time;

determining whether the advertisements have been delivered; and

terminating advertisements upon reaching the quota.

2. (previously presented) The method of claim 1 wherein said plurality of service options includes temporal based services.

3-4. (canceled)

5. (previously presented) The method of claim 1 wherein said step of providing advertisements comprises providing advertisements when end user preferences corresponds with vendor criteria.

6. (previously presented) The method of claim 1 further including a step requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service.

7. (previously presented) The method of claim 1 wherein said step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list.

8. (previously presented) The method of claim 1 wherein said step of providing advertisements comprises providing advertisements based upon a shopping history of said end user.

9-10. (canceled)

11. (previously presented) The method of claim 1 wherein said step of providing advertisements comprises providing advertisements at predetermined times based upon user device habits.

12. (canceled).



13. (previously presented) A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options;

providing a quota of advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device and when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time;

requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service; and

terminating advertisements upon reaching the quota.

14. (canceled)

15. (previously presented) The method of claim 13 wherein said step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list.

16. (previously presented) The method of claim 15 wherein said step of providing advertisements comprises providing advertisements based upon a shopping history of said end user.

17. (previously presented) The method of claim 13 wherein said step of providing advertisements comprises providing advertisements based upon advertisement acceptance.

18. (canceled)

19. (previously presented) The method of claim 13 wherein said step of providing advertisements comprises providing advertisements at predetermined times based upon user device habits.

20. (canceled)

21. (canceled)

22. (previously presented) The method of claim 13, further comprising a step of conveying the determined future location of said wireless communication device to a provider of at least one of said products or services.

23-27. (canceled)

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, entered by the examiner and relied upon by the appellant in the appeal, or relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court of the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. § 41.37.